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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,347	12/17/2004	Nerina Dodic	PF4813USW	5221

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EXAMINER

GRAZIER, NYEEMAH

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/518,347

Applicant(s)

DODIC ET AL.

Examiner

Nyeemah Grazier

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 9, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 12,21 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9-11 and 13 is/are rejected.
- 7) ☐ Claim(s) 2-11,13-20,22 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/17/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION
FIRST ACTION ON THE MERITS

I. ACTION SUMMARY

Claims 1-27 are currently pending. Claims 12, 25 and 26 are withdrawn from further consideration by the Examiner because said claims are drawn to a non-elected invention. 37 C.F.R. § 1.142(b). Claims 21, 23, and 24 have been canceled.

II. PRIORITY

This application is a 371 of PCT/EP03/06417, filed on June 18, 2003. Applicant's claim to foreign priority pursuant to 35 U.S.C. 119 (a-d) to United Kingdom 0214139.8 filed on June 19, 2002 is acknowledged.

III. INFORMATION DISCLOSURE STATEMENT

The information disclosure statement (IDS) submitted on December 17, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

IV. RESTRICTION/ELECTION

A. Election: Applicant's Response

Applicant's election with traverse of Group IV, claims 1-20, 22 and 27 in the response filed on August 9, 2006 is acknowledged.

The applicant traverses the restriction on the grounds that the restriction is improper because the Applicant asserts that the compounds share a special technical feature and a common structural core. Applicant's arguments have been fully considered and are not persuasive for the reasons set forth in the Restriction Letter.

Furthermore the products are distinct. In the instant invention, the compounds of formula (I) contain a heterocyclic ring, which may represent pyrazole or oxazole for example.

In sum, Formula (1) have diverse chemical structures, different chemical properties, different modes of action, and different effects and reactive conditions and is therefore recognized in the art as being distinct from one another. MPEP §§ 806.04, 808.01. Additionally, the level of skill in the art is not such that one invention would be obvious over the other invention, i.e. they are patentable over each other. Chemical structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The rebuttable presumption, that similar chemical structures behave similarly, may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holding of Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lulu, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

The requirement is still deemed proper and is therefore made FINAL.

B. Status of the Claims

i. Scope of the Elected Subject Matter

The scope of the elected subject matter are the compounds of Formula (1)

wherein:

Y is nitrogen,

Z is nitrogen,

X is CH,

R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 , R^8 , R^9 , R^{10} , D, and n have the original definitions as stated in Claim 1.

ii. Non-elected Subject Matter Withdrawn 37 C.F.R. §1.142(b)

The non-elected subject matter withdrawn are the compounds of formula (1)

wherein:

At least one of X, Z, and Y represent a heteroatom selected from O, S, or N,

EXCEPT where Y is nitrogen, Z is nitrogen, X is CH.

V. REJECTION(S)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites “ At least one of X, Z and Y represents a heteroatom”, but does not state what the other variables are when one of X, Z and Y is a heteroatom.

Claims 9-11 recite limitations that lack antecedent basis. Claim 9 recite that the heterocyclic group may form thiazole, pyrazole, or oxazole. Claim 10, depends from claim 9 and recites the limitation that “one of X and Y represents CH.” Claim 11 recites “X represents CH.” Claim 9 depends from claim 1. Claim 1 does not have support for variables X, Y or Z representing CH. Thus, there is insufficient antecedent basis for this limitation in the claim.

VI. OBJECTION(S)

Claim Objections

Claim 1 is objected to because of the following informalities:

- Claim 1 recites “a compound of formula (I), but the formula is entitled “formula (1)”.
- Claim 1 should be amended by inserting “formula (I) has the following structure:” after “ester thereof, wherein” on line 2 of claim 1.
- Please insert a semicolon after “n is 0 or 1.
- Please insert “the group consisting of” after the phrase “ X, Z, and Y represents a heteroatom selected from”.
- Claim 1 is objected to because R7 may represent “C1-6 alkenyl.” This should be changed to C2-C6 alkenyl for variable R5 and R7.
- Insert a comma after R6 is halogen in claim 13.
- Claim 19 is objected to because R7 may represent “C1-3 alkenyl.” This should be changed to C2-C3 alkenyl for variable R5 and R7.

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Appropriate correction is required.

Claim Objection-Non Elected Subject Matter

Claims 1, 9, 10, and 27 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should amend the claims by deleting the non-elected subject matter.

Dependent Claim Objections

Dependent Claims 2-11, 13-20, 22, and 27 are also objected to as being dependent upon a rejected based claim.

VII. ALLOWABLE SUBJECT MATTER

The allowable subject matter are the products of formula (1) wherein wherein: Y is nitrogen, Z is nitrogen, and X is CH.

VIII. CONCLUSION


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:30 a.m. - 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Very truly yours,



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